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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/663,697 | 09/17/2003 | Hitoshi Nagata | 031156 | 3967 |

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EXAMINER

CAO, ALLEN T

ART UNIT PAPER NUMBER

2652

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,697

Applicant(s)

NAGATA ET AL.

Examiner

Allen T. Cao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/24/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/663,696. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

a) Claims 1-2 and 4 of the present invention application are substantially same as the combination limitations of claims 1-3 and 12-13 of the copending application 10/663,696. All the major limitations of the claims 1-2 and 4 of the present invention application have been disclosed by the copending application 10/663,696 except some minor used languages.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange the combination limitations of claims 1-3 and 12 of the copending application in order to match with the limitations of claims 1-2 and 4 as set forth in present invention application.

b) Claim 3 of the present invention application is substantially same as claim 2 of the copending application 10/663,696.

c) Claim 4 of the present invention application is same as claim 13 of the copending application 10/663,696.

d) Claim 5 of the present invention application is substantially same as claim 1 of the copending application 10/663,696.

e) Claim 6 of the present invention application is substantially same as claim 4 of the copending application 10/663,696.

f) Claim 7 of the present invention application is same as claim 5 of the copending application 10/663,696.

g) Claim 8 of the present invention application is same as claim 6 of the copending application 10/663,696.

h) Claim 9 of the present invention application is same as claim 7 of the copending application 10/663,696.

i) Claim 10 of the present invention application is same as claim 9 of the copending application 10/663,696.

j) Claim 11 of the present invention application is same as claim 10 of the copending application 10/663,696.

k) Claim 12 of the present invention application is same as claim 11 of the copending application 10/663,696.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 3-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) The phrase "the disk inlet/outlet port" in claim 3, lines 2-3 is vague and indefinite because it lacks antecedent basis. The disk inlet/outlet port has not been introduced in the precedent claims.

b) The member "the second disk tray" in claim 4, lines 6-7 is vague and indefinite because it lacks antecedent basis. The second disk tray has not been introduced in the precedent claims; therefore, it also lacks a structural relationship between the disk drive, the second tray and a bare disk.

Appropriate correction is required.

4. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 2 is substantially same as claim 1 except the phrase "or a/the bare disk"; however, the term "or" considered an alternative choice.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawamura et al (US. 5,812,511).

Kawamura et al discloses a reproducing/recording apparatus comprising a first reproducing/recording mechanism (the head, for example: the head 13) for reproducing data from and/or recording data onto a cartridge/disk combination 62, a disk main body being contained in the cartridge (figure 2); the first reproducing/recording mechanism having a traversing mechanism disposed oppositely relative to the recording area of said cartridge/disk combination (figures 9A-9C, 14A-15C, 26A-26C show a traversing mechanism) and a clamping mechanism 8 disposed oppositely relative to the traversing mechanism with the cartridge/disk combination interposed between them, the clamping mechanism having a keep member (balls 35) adapted to urge (push) said cartridge/disk combination toward the side of the traversing mechanism at the time of clamping said cartridge/disk combination (column 9, lines 15-38), all as set forth in claims 1 and 2.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura et al in view of Inoue et al (US. 6,665,255 B1).

Kawamura et al also discloses that the first reproducing/recording mechanism is arranged at the side of the disk inlet/outlet and the bare disk is arranged remotely from

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the disk inlet/outlet port with the reproducing/recording mechanism interposed between them.

Kawamura et al, however, does not disclose a second reproducing/recording mechanism for reproducing data from and/or recording data onto a bare disk.

Inoue et al discloses a loading/unloading mechanism having a first reproducing/recording mechanism 3 for read/write data from a disk cartridge CDS (column 8, line 62 to column 9, line 17; see also claim 1); and a second reproducing/recording mechanism 4 for read/write data from a bare disk DS (column 7, line 59 to column 8, line 2; see also claim 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the loading/unloading apparatus of Kawamura et al with an additional second read/write mechanism as set forth, supra as taught by Inoue et al.

The rationale is as follows: One of ordinary skill in the art would have been motivated to provide the loading/unloading apparatus of Kawamura et al with an additional second read/write mechanism as set forth, supra as taught by Inoue et al to speed up the write/read characteristics of the disk cartridge and the bare disk in order to improve the read/write characteristics of the disk apparatus. Additionally, it also provide a more variety choices of loading/unloading different media.

9. Claims 4-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen T. Cao whose telephone number is (571) 272-7569. The examiner can normally be reached on Mon - Thurs (7:30 - 6:00).

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Allen Cao
Primary Examiner

AC
July 11, 2005